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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,172	05/19/1999	HIROKI KANNO	016907/0967	4798

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FOLEY & LARDNER
SUITE 500
3000 K STREET N W
WASHINGTON, DC 200075109

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/314,172

Applicant(s)

KANNO ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/24/03 has been entered.

Response to Amendment

2. Applicant's amendment received on 11/26/03 has been entered and made of record. Currently, **claims 19-25** are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 19-21 and 25** are rejected under 35 U.S.C. 102(b) as being anticipated by Li *et al.* (U.S. Patent Number 5,506,697).

Regarding **claim 19**, Li discloses an image forming apparatus (see Figs. 3, 7 and 8, column 7, lines 53 through 56, and column 11, line 41 through column 12, line 2) comprising

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reading means for reading a document and providing image data on the document as first image data (scanner 42, column 7, lines 48 through 54), image processing means for processing the first image data provided by the reading means (column 7, lines 48 through 61, and column 11, line 41 through column 12, line 34), image forming means for forming an image on a sheet of paper corresponding to input image data (printer 46, column 7, line 56 through column 8, line 3, and column 12, lines 28 through 34), operating condition image producing means for producing image data as second image data (code symbol 45, being produced by the encoder 44, column 7, lines 46 through 56), indicative of at least one of operating conditions which determine image quality of the reading means, the image processing means and the image forming means (column 8, lines 4 through 26, column 9, lines 12 through 42, and column 11, lines 20 through 40), synthesizing means for synthesizing the first image data processed by the image processing means with the second image data produced by the operating condition image producing means (see Fig. 3, coded symbol 45, printed on document 50, column 7, line 56 through column 8, line 3), means for controlling the image forming means to form an image corresponding to the first and second image data synthesized by the synthesizing means on the sheet of paper (see Fig. 3, coded symbol 45, printed on document 50, column 7, line 56 through column 8, line 3, and column 12, lines 11 through 20), means for designating whether or not the first image data obtained by the image processing means should be synthesized with the second image data produced by the operating condition image producing means (being the designation of encoded symbol mode, seen as step 172 in Fig. 8, column 12, lines 3 through 28), and the synthesizing means synthesizes the first image data obtained by the image processing means with the second image data produced by the operating condition image producing means and provides resultant

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synthesized image data in a case where the designating means designates synthesis (step 180, when designated to be in the symbol mode, as “yes” in step 172, column 12, lines 11 through 20), and provides only the first image data obtained by the image processing means in other cases (step 174, column 12, lines 6 through 10).

Regarding *claims 20 and 21*, Li discloses the apparatus discussed in claim 19, and further teaches that the operating condition image processing means includes means for producing a character image data and a pattern code image data indicative of the operating conditions (column 7, line 56 through column 8, line 34).

Regarding *claim 25*, Li discloses the apparatus discussed in claim 19, and further teaches that the operating condition image processing means includes means for producing an image data indicative of processing conditions of the image processing means (column 4, line 62 through column 5, line 12, and column 8, lines 4 through 34).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 22-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Li *et al.* (U.S. Patent Number 5,506,697) in view of Antognini *et al.* (U.S. Patent Number 6,176,427).

Regarding *claim 22*, Li discloses the apparatus discussed in claim 19, but fails to particularly teach if the operating condition image processing means includes means for

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producing an image data indicative of input conditions of the reading means. Antognini discloses an image forming apparatus (see Fig. 24) comprising reading means for reading a document and providing image data on the document as first image data (being inherent in a facsimile machine, column 22, line 47 through column 23, line 7, column 47, lines 28 through 45, and column 48, lines 1 through 28), image processing means for processing the first image data provided by the reading means (steps 2401 and 2402, column 47, lines 28 through 38), image forming means for forming an image on a sheet of paper corresponding to input image data (printed onto a substrate at step 2404, whereby a printer is inherently in a facsimile machine), operating condition image producing means for producing image data as second image data (digitally encoded substrate, see Figs. 1 and 2), indicative of at least one of operating conditions which determine image quality of the reading means, the image processing means and the image forming means (see Fig. 2, column 19, lines 3 through 26, column 20, lines 15 through 57, and column 24, line 59 through column 25, line 14), synthesizing means for synthesizing the first image data processed by the image processing means with the second image data produced by the operating condition image producing means (see Fig. 9, column 22, line 47 through column 23, line 7, and step 2404, column 47, lines 28 through 62), means for controlling the image forming means to form an image corresponding to the first and second image data synthesized by the synthesizing means on the sheet of paper (step 2404 in Fig. 24, column 47, lines 28 through 62). Further, Antognini teaches that the operating condition image processing means includes means for producing an image data indicative of input conditions of the reading means (column 19, lines 3 through 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Antognini in the system of Li. Li's system would

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easily be modified to include Antognini's teachings, as the systems share cumulative features, being additive in nature, therein being able to determine the optimum printer/scanner combination for the desired output, as recognized by Antognini.

Regarding *claim 23*, Li discloses the apparatus discussed in claim 19, but fails to particularly teach if the operating condition image processing means includes means for producing an image data indicative of a resolution and sampling rate of the reading means. Antognini discloses an image forming apparatus (see Fig. 24) comprising reading means for reading a document and providing image data on the document as first image data (being inherent in a facsimile machine, column 22, line 47 through column 23, line 7, column 47, lines 28 through 45, and column 48, lines 1 through 28), image processing means for processing the first image data provided by the reading means (steps 2401 and 2402, column 47, lines 28 through 38), image forming means for forming an image on a sheet of paper corresponding to input image data (printed onto a substrate at step 2404, whereby a printer is inherently in a facsimile machine), operating condition image producing means for producing image data as second image data (digitally encoded substrate, see Figs. 1 and 2), indicative of at least one of operating conditions which determine image quality of the reading means, the image processing means and the image forming means (see Fig. 2, column 19, lines 3 through 26, column 20, lines 15 through 57, and column 24, line 59 through column 25, line 14), synthesizing means for synthesizing the first image data processed by the image processing means with the second image data produced by the operating condition image producing means (see Fig. 9, column 22, line 47 through column 23, line 7, and step 2404, column 47, lines 28 through 62), means for controlling the image forming means to form an image corresponding to the first and second

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image data synthesized by the synthesizing means on the sheet of paper (step 2404 in Fig. 24, column 47, lines 28 through 62). Further, Antognini teaches that the operating condition image processing means includes means for producing an image data indicative of a resolution (column 19, lines 3 through 26, column 20, lines 15 through 57, and column 24, line 59 through column 25, line 14) and sampling rate of the reading means (column 15, line 18 through column 16, line 16). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Antognini in the system of Li. Li's system would easily be modified to include Antognini's teachings, as the systems share cumulative features, being additive in nature, therein being able to determine the optimum printer/scanner combination for the desired output, as recognized by Antognini.

Regarding *claim 24*, Li discloses the apparatus discussed in claim 19, but fails to specifically teach if the operating condition image processing means includes means for producing an image data indicative of output conditions of the image forming means. Antognini discloses an image forming apparatus (see Fig. 24) comprising reading means for reading a document and providing image data on the document as first image data (being inherent in a facsimile machine, column 22, line 47 through column 23, line 7, column 47, lines 28 through 45, and column 48, lines 1 through 28), image processing means for processing the first image data provided by the reading means (steps 2401 and 2402, column 47, lines 28 through 38), image forming means for forming an image on a sheet of paper corresponding to input image data (printed onto a substrate at step 2404, whereby a printer is inherently in a facsimile machine), operating condition image producing means for producing image data as second image data (digitally encoded substrate, see Figs. 1 and 2), indicative of at least one of operating

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conditions which determine image quality of the reading means, the image processing means and the image forming means (see Fig. 2, column 19, lines 3 through 26, column 20, lines 15 through 57, and column 24, line 59 through column 25, line 14), synthesizing means for synthesizing the first image data processed by the image processing means with the second image data produced by the operating condition image producing means (see Fig. 9, column 22, line 47 through column 23, line 7, and step 2404, column 47, lines 28 through 62), means for controlling the image forming means to form an image corresponding to the first and second image data synthesized by the synthesizing means on the sheet of paper (step 2404 in Fig. 24, column 47, lines 28 through 62). Further, Antognini teaches that the operating condition image processing means includes means for producing an image data indicative of output conditions of the image forming means (column 10, lines 34 through 46, and column 19, lines 3 through 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Antognini in the system of Li. Li's system would easily be modified to include Antognini's teachings, as the systems share cumulative features, being additive in nature, therein being able to determine the optimum printer/scanner combination for the desired output, as recognized by Antognini.

Citation of Pertinent Prior Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Soscia (U.S. Patent number 6,636,332) discloses a system for reproducing images using an overlaid indicia printed on an original captured image; and

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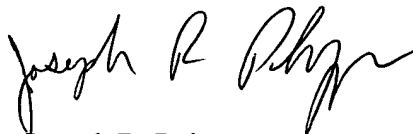
Prasad *et al.* (U.S. Patent Number 5,818,966) discloses a system of encoding color information on a printed document.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp